



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,287	07/09/2003	Hiroynki Takahashi	16816	9906
23389 7590 09/08/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3769				
MAIL DATE		DELIVERY MODE		
09/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/616,287

Applicant(s)

TAKAHASHI, HIROYUKI

Examiner

david shay

Art Unit

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 4, 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-42 is/are pending in the application.
- 4a) Of the above claim(s) 41 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Applicant's amendments filed June 4, 2009 have overcome the rejections under 35 U.S.C. 112, first and second paragraph.

With regard to the obviousness rejections, applicant argues that the claim language, particularly that in indents 8-10 of e.g. claim 33 “provides a surgery system in which the relation of a first medical device and a second medical device is not a constant master-slave relation but is a relation of decentralized control (i.e., parallel relation) in which the master-slave relation is interchangeable.” (see the instant response, page 10, last paragraph, emphasis in original). While this may be so, the claims as they currently stand, are not limited to this configuration. The claims would also read on a system wherein there is a third control device, not associated with the first or second devices, and which is the actual “master” and that device determines which of the second or first device will receive and act on the received signals and transmits the information on a common bus.

While applicant's piecemeal arguments of the references are noted, the examiner submits that the combination applied to the claims renders the claimed subject matter obvious.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15-17, 22, 33, 42, 43, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Published Application Publication JP 2001-178734 to Takahashi in combination with Peterson et al. Takahashi (JP '734) teaches a control system for multiple medical devices comprising a first instrument control part (Fig. 7, # 112) with an output part (Fig. 7, # 113) connected to a first instrument in a probe (Fig. 7, # 105) via a connector (Fig. 7, # 119). The output portion is interpreted as providing a drive signal to the device. The connector also acts to identify the device attached via an instrument identification portion (Fig. 7, # 116) using a resistance detector (Fig. 2). The probe also contains a second device controlled by a second control portion (Fig. 7, # 122). Switches are disclosed that control the two instruments (Fig. 7, #s 106 & 107). A communications line (Fig. 7, # 108) connects and transfers data between the two control portions. The data may include instrument identification and the status of the switches. Based on the determination of the identity of the device, the control parameters are set and a determination is made as to whether to interlock the devices; that is whether the devices may operate together or separately. Multiple operational modes are disclosed wherein based on the switch positions, the instruments involved and determination of permission to operate together (interlock), operation may be controlled independently by each switch, or one switch is enabled to control both devices. Peterson et al teach providing medical devices that can be cascaded, and allowing one of the devices to be configured either as a master or a slave. It would have been obvious to one skilled in the art to enable one of the devices of Takahashi (JP '734) to be configured as a master and the other devices to be configured as slaves, since this

would enable coordinated control of the devices and prevent the occurrence of erroneous or undesirable operations, and to cause this to happen automatically upon replacement of the device, since this is merely the substitution of an automatic means for a manual one, which is obvious (see *In re Venner*, 262 F.2d 91, 120 USPQ 192 (CCPA 1958)), thus producing a device such as claimed.

Applicant's arguments with respect to claims 33-40 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed June 4, 2009 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3769